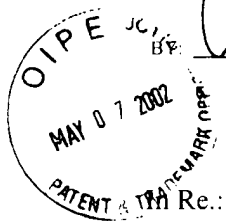


I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, DC 20231, ON THE DATE INDICATED BELOW.



By: Victoria Alfnes

DATE: 4/26/02

\$1615 ✓

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

# 9

In Re.: Patent Application of  
Peter Watts  
  
Conf. No.: 5106  
  
Appln. No.: 09/749,152  
  
Filed: December 27, 2000  
  
Title: COLONIC DRUG DELIVERY  
COMPOSITION

:  
: Group Art Unit: 1615  
:  
:  
:  
:  
: Attorney Docket  
: No. 10774-21U1  
: (WESZ/P14089U1)  
: (P-0129)

**RECEIVED**

MAY 10 2002

TECH CENTER 1600/2900

**COPY OF PAPERS  
ORIGINALLY FILED**

**REQUEST FOR NEW NON-FINAL OFFICE ACTION**

This Request is being filed in response to the final Office Action mailed January 4, 2002 (Paper No. 8) and is accompanied by a Petition for a one-month extension of time.

Applicants hereby request a new non-final Office Action in view of the fact that Paper No. 9 is non-responsive, cites a new reference, and introduces a new ground of rejection that is neither necessitated by the Applicants' amendment nor based on information submitted in an Information Disclosure Statement under 37 C.F.R. § 1.97(c). In a final office action, "the final rejection... should include a rebuttal of any arguments raised in the applicants' reply." M.P.E.P. § 706.07.

Although the cover page of the final Office Action indicates that it is responsive to applicants' communications filed October 16, 29001, the Examiner has failed to fully address the arguments filed on that date related to the outstanding § 103 rejection. Rather, at page 4, the Examiner has incorrectly stated the applicants' arguments relating to the effective date of certain subject matter in Kelm, and dismissed them in a conclusory and improper fashion.

Additionally, the Examiner, in her "Response to Arguments" section, has

introduced a new obviousness rejection on a new ground based upon the combination of Kelm with a new reference (Mandel), and has not provided any analysis as to how the Kelm-Mandel combination meets the elements of *prima facie* case of obviousness. The mere fact that Kelm and Mandel are related applications does not discharge the Examiner of her obligation to provide a proper § 103 rejection when making a combination.

As Applicants' arguments regarding the § 103 rejection based upon Kelm have not been fully addressed, and because the Examiner has apparently given a new rejection based upon the combination of Kelm and newly-cited Mandel, while failing to provide proper analysis, the outstanding Office Action (Paper No. 8) is non-responsive and improper. The Applicants have no basis for responding to the Examiner's rejections because the Examiner has made conclusory arguments without any reasoning to which Applicants can comment or respond. A new **non-final** Office Action is respectfully requested.

Respectfully submitted,

**PETER WATTS**

26 April 2002  
(Date)

By:

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